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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,088	12/29/2000	Douglas E. Love	7000-051	5020
27820	7590	11/18/2003	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C. P.O. BOX 1287 CARY, NC 27512			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,088

Applicant(s)

LOVE ET AL

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-11, 13, 15-16, 18-20, 22, 24-28, 30, 32-33, 35-37, 39, 41-45, 47, 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5,7-11,13,15,16,18-20,22,24-28,30,32,33,37,39,41-45,47 and 49-51.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5, 7-11, 13-16, 18-20, 22, 24-28 and 30-33 are rejected under 35 U.S.C. 101.

Claims 1-3, 5, 7-11 and 13-16 are rejected under 35 U.S.C. 101 because the claimed method for cost sharing of toll calls does not recite a limitation in the technological arts. The independently claimed steps of: receiving a request; receiving proposed toll sharing parameters, initiating a toll call, informing the call recipient, receiving a decision, and apportioning the cost for the toll call, are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: "initiating a toll call" may be understood as merely two people talking over the phone. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Claims 18-20, 22, 24-28 and 30-33 are rejected under 35 U.S.C. 101 because the claimed system for cost sharing of toll calls does not recite a limitation in the technological arts. The independently claimed system does not provide any technical limitations, and only recites the method steps of above-referenced **claims 1-3, 5, 7-11 and 13-16**. The claimed language: "a system for sharing costs associated with toll calls" may be understood as merely two people talking over the phone. However, the

claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20, 22, 24-28, 30-33, 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-20, 22, 24-28 and 30-33 are confusing, because these claims claim a system while reciting only method steps.

Also, **claim 22** is confusing, because it structured to be dependent from **claim 21**, which is canceled by the applicant.

Claims 49 and 50 are confusing, because these claims are structured to be dependent from **claim 46**, which is canceled by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-11, 13, 15-16, 18-20, 22, 24-28, 30, 32-33, 35-37, 39, 41-45, 47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al. (US 6,282,274).

Jain et al. teach a method and system for selectable billing options for single communications account, comprising:

As per claims 1, 18 and 35,

receiving a request for toll sharing from a call initiator (column 4, lines 1-7, 17-25; column 9, lines 31-45);

receiving proposed toll-sharing parameters (column 4, lines 1-7, 17-25; column 9, lines 31-45);

initiating the toll call to a call recipient (column 9, lines 31-45);

querying the recipient database for obtaining the default billing preferences (column 9, lines 45-49);

apportioning the costs for the toll call between the parties based on the toll sharing parameters (column 9, lines 31-49).

Jain et al. do not specifically teach that obtaining the recipient's default billing preferences includes obtaining a decision from the call recipient as to whether to accept the toll sharing parameters.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jain et al. to include that obtaining the recipient's default

Art Unit: 3629

billing preferences includes obtaining a decision from the call recipient as to whether to accept the toll sharing parameters, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Jain et al. would perform the invention as claimed by the applicant with either specifying recipient's decision, or not.

As per claims 2-3, 5, 7, 19-20, 22, 24, 36-37, 39 and 41,

Generating billing information for each call participants (column 9, lines 31-49).

As per claims 13, 15-16, 30, 32-33, 47 and 49-50,

facilitating interaction with the call originator to provide the toll sharing parameters for the call (column 4, lines 1-7, 17-25).

As per claims 8-9, 25-26 and 42-43, said method and system, wherein the toll sharing parameters are defined to apply to any toll calls occurring within a defined period of time (column 9, lines 31-49).

As per claims 10, 27 and 44, said method and system, wherein the toll sharing parameters are defined to apply to at least one portion of the toll call (column 4, lines 1-7, 17-25).

As per claims 11, 28 and 45, said method and system, wherein the toll sharing parameters are defined to apply to at least one portion of the toll call having a defined length (column 4, lines 1-7, 17-25).

Conclusion

Art Unit: 3629

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3629

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

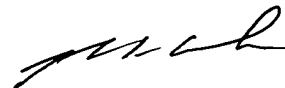
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
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